## Form PTO-1449

# INFORMATION DISCLOSURE CITATION IN A PATENT



(several sheets followed)

Docket No. 223002010004

Application No.: 09/884,455

Applicant:

Michael Houghton et al.

Filing Date: June 18, 2001

Group Art Unit: 1656 Examiner: William W. Moore

Confirmation No.: 1938

Delivery Date: September 14, 2009

#### **U.S. PATENT DOCUMENTS**

Examiner Initials	Ref. No.	Date	Document No.	Name	Class	Subclass	Filing Date if Appropriate
	1.	09/27/94	5,350,671	Houghton et al.			
	2.	12/13/94	5,372,928	Miyamura et al.			
	3.	02/16/99	5,871,903	Miyamura et al.			

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	4.	04/24/85	EP 0 138 111 B1	Europe				
	5.	05/31/89	EP 0 318 216 B1	Europe				
	6.	06/01/89	WO 89/04669	PCT				

#### OTHER DOCUMENTS

Examiner Initials	Ref. No.	OTHER DOCUMENTS	(including author, title, date, etc.)
	7.		Ant Agouron Pharmaceuticals Incorporated. Chiron Case No. C 98-2995 CW (PJH) (Related Cases C I States District Court, Northern District of

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Examiner Initials	Ref. No.	OTHER DOCUMENTS (including author, title, date, etc.)
	8.	Joint Response to Chiron's Claim Chart Pursuant to Civil Local Rule 16-9(b) on U.S. Patent Nos. 5,371,017, 5,585,258 and 5,397,691 by Defendants Eli Lilly and Company and Vertex
		Pharmaceuticals Incorporated. Chiron Corporation v. Eli Lilly and Company, and Vertex Pharmaceuticals Inc.: Case No. C 98-2974 (Related Action Nos. C 98-2994 CW and C 98-2995 CW). In the United States District Court, Northern District of California, Oakland Division, 32
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	11.	Bazan et al. (1989). "Detection of a trypsin-like serine protease domain in flaviviruses and pestiviruses" <i>Virology</i> 171:637-639.
	12.	Bazan et al. (1989). "Viral branches of the trypsin-like protease family" in UCLA Symposia on Molecular & Cellular Biology, 18th Annual Meeting, <i>J. Cell. Biochem.</i> 13A:50 (Abstract A101).
	13.	Bazan et al. (1989). "Comparative analysis of viral cysteine protease structural models" <i>FEBS Lett</i> . 249(1):5-7.
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	15.	Biedrzycka et al. (1987). "Characterization of protease cleavage sites involved in the formation of the envelope glycoprotein and three non-structural proteins of dengue virus type 2, New Guinea C strain" <i>J. Gen. Virol.</i> 68:1317-1326.
	16.	Boonmar et al. (1990). "Molecular Cloning of Hepatitis C Virus cDNA from Plasma of an Implicated Donor of Posttransfusion Non-A, Non-B Hepatitis" in <u>Proceedings of the 1990 International Symposium On Viral Hepatitis and Liver Disease.</u> Blaine et al. eds., Williams & Wilkins: Baltimore, pp. 371-374.
	17.	Bradley et al. (1991). "Hepatitis C virus: Background and strategies for cloning a major etiologic agent for PT-NANBH" in <u>Viral Hepatitis and Liver Disease</u> : <u>Proceedings of the 1990 International Symposium on Viral Hepatitis and Liver Disease</u> : <u>Contemporary issues and Future Prospects</u> , Hollinger et al. eds., pp. 320-328.
	18.	Brake et al. (August, 1984). "α-factor-directed synthesis and secretion of mature foreign proteins in Saccharomyces cerevisiae" PNAS 81:4642-4646.

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	19.	Castle et al. (1986). "Primary structure of the west nile flavivirus genome region coding for all nonstructural proteins" <i>Virology</i> 149:10-26.
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	22.	Choo et al. (April 21, 1989). "Isolation of a cDNA clone derived from a blood-borne non-A, non-B viral hepatitis genome" <i>Science</i> 244:359-362.
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	25.	Choo et al. (March 1991). "Genetic organization and diversity of the hepatitis C virus" <i>PNAS</i> 88:2451-2455.
	26.	Coia et al. (1988). "Nucleotide and complete amino acid sequences of Kunjin virus: Definitive gene order and characteristics of the virus-specified proteins" J. Gen. Virol. 69:1-21.
	27.	Collett et al. (1988). "Comparisons of the pestivirus bovine viral diarrhoea virus with members of the flaviviridae" <i>J. Gen. Virol.</i> 69:2637-2643.
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	37.	Gorbalenya. (1989). "N-terminal domains of putative helicases of flavi-and pestiviruses may be serine proteases" <i>Nucl. Acids Res.</i> 17(10):3889-3897.
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•	62.	Strauss et al. (1986). "Replication of alphaviruses and flaviviruses: Proteolytic processing of polyproteins" in <u>Positive Strand RNA Viruses: Proceedings of a UCLA Symposium held in Keystone, Colorado</u> , Brinton et al., eds., Alan R. Liss: New York, pp. 209-225.
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	102.	06/02/1981	4,271,145	Wands et al.			
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	179.	09/01/1982	0 058 676	Europe				-
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	182.	01/05/1983	0 068 465	Europe				
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	193.	08/13/1986	0 190 972	Europe				
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	195.	10/01/1986	0 196 056	Europe				
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	198.	04/13/1988	0 263 761	Europe				
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Examiner: William W. Moore
Confirmation No.: 1938

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	903.	Defendant Gilead Sciences, Inc.'s Answer to Complaint and Counterclaims, Chiron Corporation v. Gilead Sciences, Inc.: Case No. C-98-2994 VRW, United States District Court, Northern District of California. 09/21/98
	904.	Answer and Counterclaims of Defendant Agouron Pharmaceuticals, Inc. Chiron Corporation v. Agouron Pharmaceuticals, Inc.: Civil Action No. C-98-2995 SI. United States District Court, Northern District of California. 10/01/98
	905.	Defendant Gilead Sciences, Inc.'s Initial Disclosure of Prior Art Pursuant to Civil Local Rule 16-7. Chiron Corporation v. Gilead Sciences, Inc., and Related Actions: Case No. C-98-2994 CW. United States District Court, Northern District of California. 11/10/98
	906.	Vertex's Initial Disclosure of Prior Art for U.S. Patent Nos. 5,371,017, 5,585,258 and 5,597,691 under Local Rule 16-7(d). Chiron Corporation v. Eli Lilly and Company, and Vertex Pharmaceuticals Inc. Civil No. 98-2974 CW (ENE). United States District Court, Northern District of California. 11/12/98
	907.	Lilly's Initial Disclosure of Prior Art for U.S. Patent Nos. 5,371,017, 5,585,258, and 5,597,691 Under Local Rule 1607(d)-(f). 11/12/98
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	909.	Answer of Defendant Vertex Pharmaceuticals Incorporated. Chiron Corporation v. Eli Lilly & Co., and Vertex Pharmaceuticals Incorporated. Case No.: C-98-2974 CW [PJH], Related Action Nos: C-98-2994 CW [PJH] and C-98-2995. 02/01/99
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	911.	Vertex's Second Supplemental Disclosure of Prior Art for U.S. Patent Nos. 5,371,017, 5,585,258 and 5,597,691 Under Local Rule 16-7(d). Chiron Corporation v. Eli Lilly and Vertex Pharmaceuticals Inc. Civil No. 98-2974 CW (PJH), Related Action Nos. C-98-02994 CW [PJH] and C-98-02995 CW [PJH]. 02/12/99

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	913.	Response Chart to Chiron's Claim Chart on U.S. Patent Nos. 5,371,017, 5,585,258 and 5,397,691 Pursuant to Local Rule 16-9(b) by Defendant Gilead Sciences, Inc. Case No. C-98-2994 CW [PJH]. 03/22/99
	914.	Response Chart to Chiron's Claim Chart on U.S. Patent Nos. 5,371,017, 5,585,258 and 5,397,691 Pursuant to Local Rule 16-9(b) by Defendant and Counterclaimant Gilead Sciences, Inc. Chiron Corporation v. Gilead Sciences, Inc. Case No. C-98-2994 CW [PJH], Related Action Nos. C-98-02995 CW [PJH] and C-98-02974 CW [PJH]. 03/22/99
	915.	Agouron's Response Chart to Chiron's Claim Chart on U.S. Patent Nos. 5,371,017; 5,5585,258 and 5,397,691 Pursuant to Local Rule 16-9(b). Chiron Corporation v. Agouron Pharmaceuticals, Inc. Case No. C-98-2995 CW [PJH], Related Cases C-98-9874 CW and C-98-2994 CW. 08/04/99
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	919.	Amended Response Chart Pursuant to Civil Local Rule 16-9(b) by Defendants Eli Lilly and Company and Vertex Pharmaceuticals Incorporated. Chiron Corporation v. Eli Lilly and Company and Vertex Pharmaceuticals Inc. Case No. C-98-2974 CW, Related Action Nos. C-98-2994 CW and C-98-2995 CW. 10/22/99.
	920.	Amended Response Chart Pursuant to Civil Local Rule 16-9(b) by Defendants Eli Lilly and Company and Vertex Pharmaceuticals Inc. Chiron Corporation v. Eli Lilly and Company and Vertex Pharmaceuticals, Inc. Case No. C-98-2974 CW, Related Action Nos. C-98-2994 CW and C-98-2995 CW. 10/22/99
	921.	Amended Response Chart Pursuant to Civil Local Rule 16-9(b) by Defendants Eli Lilly and Company and Vertex Pharmaceuticals Incorporated. Chiron Corporation v. Eli Lilly and Company and Vertex Pharmaceuticals, Inc. Case No. C-98-2974 CW, Related Action Nos. C-98-2994 CW and C-98-2995 CW. 11/18/99.

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	922.	Findings of Fact, Conclusions of Law and Proposed Order for Motion 4A by Defendants Agouron Pharmaceuticals, Inc. Chiron Corporation v. Agouron Pharmaceuticals, Inc. Case No. C 98-2995 CW (PJH)
	923.	Eli Lilly and Company's and Vertex Pharmaceutical Incorporated's Proposed Findings of Fact and Conclusions of Law in Support of a Judgment to Pierce Attorney-Client Privilege and Work Product Immunity Under the Crime-Fraud Exception. Chiron Corporation v. Eli Lilly and Company and Vertex Pharmaceuticals, Inc. Case Nos. C-98-2974 CW and C-98-2995 CW.
	924.	Reporter's Transcript of Proceedings Before Special Masters Catherine A. Yanni and David W. Yount. Chiron Corporation v. Eli Lilly and Company and Vertex Pharmaceuticals, Inc.; Chiron Corporation v. Gilead Sciences, Inc.; Chiron Corporation v. Agouron Pharmaceuticals, Inc. Case Nos. C-98-2974 CW ENE, C-98-2994 CW and C-98-2995 CW. 5/24/2000.
	925.	Hearing Before Special Master. Chiron Corporation v. Eli Lilly and Company and Vertex Pharmaceuticals, Inc.; Chiron Corporation v. Gilead Sciences, Inc.; Chiron Corporation v. Agouron Pharmaceuticals, Inc. Case Nos. C-98-2974 CW ENE, C-98-2994 CW and C-98-2995 CW. 9/8/1999.
	926.	Agouron Pharmaceuticals, Inc. for Request for Examination regarding Patent No. 5,371,017 filed on December 6, 1999 with exhibits thereto.
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	929.	Agouron's Supplemental Objections and Responses to Chiron's First Set of Interrogatories (Nos. 1-16). Chiron Corporation v. Agouron Pharmaceuticals, Inc. Case No. C-98-02995 CW [PJH], Related Action Nos. C-98-02974 CW [PJH] and C-98-02994 CW [PJH]. 08/19/99
	930.	Chiron's Responses to Vertex's First Set of Requests to Admit (Nos. 1-9). Chiron Corporation v. Eli Lilly and Company and Vertex Pharmaceuticals Inc. No. C-98-02974 CW [PJH], Related Case Nos. C-98-02994 CW [PJH] and C-98-02995 CW [PJH]. 12/08/99
	931.	Chiron's Answers to Agouron's First Set of Interrogatories (Nos. 1-19). Chiron Corporation v. Agouron Pharmaceuticals, Inc. No. C-98-02995 CW [PJH], Related Case No. C-98-02974 CW [PJH]. 01/25/00
	932.	Chiron's Responses to Vertex's Second Set of Requests to Admit (Nos. 10-42). Chiron v. Eli Lilly and Company and Vertex Pharmaceuticals Inc. No. C-98-02974 CW [PJH], Related Action No. C-98-02995 CW [PJH]. 02/01/00

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	935.	Chiron's Supplemental Answers to Vertex's Second Set of Interrogatories (Nos. 8, 13-15). Chiron Corporation v. Eli Lilly and Company and Vertex Pharmaceuticals Inc. No. C-98-02974 CW [PJH], Related Case No. 98-02995 CW [PJH]. 02/16/00
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	937.	Chiron's Supplemental Responses to Lilly's First Set of Requests to Admit (Nos. 2, 24, 37 and 49), Chiron Corporation v. Eli Lilly and Company and Vertex Pharmaceuticals Inc. No. C-98-02974 CW [PJH], Related Action No. C-98-02995 CW [PJH]. 05/31/00
	938.	Chiron's Supplemental Answers to Agouron's First Set of Interrogatories (Nos. 15-19). Chiron Corporation v. Agouron Pharmaceuticals, Inc. No. C-98-02995 CW [PJH], Related Case No. C-98-02974 CW [PJH]. 06/12/00
	939.	Chiron Corporation's Responses to Defendant Eli Lilly and Company's Supplemental Interrogatories. Chiron v. Eli Lilly and Company and Vertex Pharmaceuticals Inc. No. C-98-02974 CW [PJH], Related Case No. C-98-02995 CW [PJH]. 06/12/00
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	941.	Chiron's Second Supplemental Responses to Vertex's Second Set of Requests to Admit. Chiron Corporation v. Eli Lilly and Company and Vertex Pharmaceuticals Inc. No. C-98-02974 CW [PJH], Related Action No. C-98-02995 CW [PJH]. 08/21/00
	942.	Chiron's Second Supplemental Responses to Lilly's First Set of Requests to Admit. Chiron Corporation v. Eli Lilly and Company and Vertex Pharmaceuticals Inc. No. C-98-02974 CW [PJH], Related Action No. C-98-02995 CW [PJH]. 08/21/00
	943.	Duplicate of Reference No. 938.
	944.	Excerpt from Laboratory Notebook of Qui-Lim Choo dated June 9, 1989, page 9.
	945.	Excerpt from Laboratory Notebook of Qui-Lim Choo dated August 22, 1989, page 25.

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	946.	Civil Action No. C 98-2974 (CW) Chiron Corporation 524 at 1/25/00 deposition of A. Gorbalenya.	v. Eli Lilly, Subpoena in a civil case duces tecum, Ex.
-	947.	Transcript of deposition of Dr. Alexander E. Gorbalen C-98-02994 CW and C-98-0295 CW) in Chiron Corp. before the U.S. District Court Northern District of Cali	v. Eli Lilly and Co. and Vertex Pharmaceuticals, Inc.
	948.	Letter from HJ. Thiel to A. Gorbalenya dated Septem Gorbalenya.	ber 11, 1990, Ex. 515 at 1/25/00 deposition of A.
	949.	Letter from HJ. Thiel to A. Gorbalenya dated Decem Gorbalenya.	ber 28, 1990, Ex. 519 at 1/25/00 deposition of A.
	950.	Letter from A. Gorbalenya to M. Collett dated March 2 Gorbalenya.	28, 1989, Ex. 512 at 1/25/00 deposition of A.
	951.	Letter from HJ. Thiel to A. Gorbalenya dated Octobe Gorbalenya.	r 24, 1990, Ex. 517 at 1/25/00 deposition of A.
	952.	Letter from A. Gorbalenya to M. Houghton dated May Gorbalenya.	20, 1990, Ex. 514 at 1/25/00 deposition of A.
	953.	Letter from A. Gorbalenya to HJ. Thiel dated Decem Gorbalenya.	ber 1990, Ex. 518 at 1/25/00 deposition of A.
	954.	Letter from A. Gorbalenya to S. Siddell dated February Gorbalenya.	y 17, 1991, part of Ex. 520 at 1/25/00 deposition of A.
	955.	Letter from S. Siddell to A. Gorbalenya dated March 5 Gorbalenya.	, 1991, Ex. 521 at 1/25/00 deposition of A.
	956.	Letter from A. Gorbalenya and E. Koonin to S. Siddell A. Gorbalenya.	dated June 4, 1991, Ex. 523 at 1/25/00 deposition of
	957.	Letter from M. Collett to A. Gorbalenya dated April 12 Gorbalenya.	3, 1989, Ex. 513 at 1/25/00 deposition of A.
	958.	The Journal of Virology "Referee's report on Paper" N of A. Gorbalenya.	March 11, 1991, part of Ex. 522 at 1/25/00 deposition
	959.	The Journal of General Virology, receipt for manuscripentitled "Hepatitis C virus encodes a putative serine prestiviruses," both part of Ex. 520 at 1/25/00 deposition	otease related to the proteases of flavi- and

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	960.	The Journal of General Virology, "Referee's report on Paper" February 28, 1991, part of Ex. 522 at 1/25/00 deposition of A. Gorbalenya.
	961.	Chiron Laboratory Notebook #1298, pp. 184-190, 192 (Nov., 1986); (previously considered in US 08/103,961, reference I.A.117).
	962.	Independent Legal Opinion Concerning Hepatitis C Inventorship Dispute", Jun. 1991; (previously considered in US 08/103,961, reference I.A.109).
	963.	Inventorship Opinion of Gladys Monroy dated Jun. 7, 1988; (previously considered in US 08/103,961, reference I.A.119).
	964.	Letter dated Oct. 16, 1989 from Mr. Lanman of the NIH to Robert Blackburn of Chiron Corporation.
	965.	Memorandum by Dr. Houghton, dated Nov. 10, 1987; (previously considered in US 08/103,961, reference I.A.118).
-	966.	Memorandum by Dr. Michael Houghton (undated); (previously considered in US 08/103,961, reference I.A.116).
	967.	Memorandum dated Nov. 11, 1987 by Dr. Michael Houghton; (previously considered in US 08/103,961, reference I.A.115).
	968.	Memorandum Re Interview of Dr. Daniel Bradley dated Apr. 11, 1991; (previously considered in US 08/103,961, reference I.A.112).
	969.	Memorandum Re Interview of Dr. Lacy Overby dated Jun. 21, 1991; (previously considered in US 08/103,961, reference I.A.114).
	970.	Memorandum Re Interview of Dr. Michael Houghton dated May 8, 1991; (previously considered in US 08/103,961, reference I.A.111).
	971.	Memorandum Re Interviews of Dr. Amy Weiner and Dr. Gary Van Nest dated Apr. 30, 1991; (previously considered in US 08/103,961, reference I.A.113).
	972.	Memorandum Re Interviews of Dr. Qui-Lim Choo and Dr. George Kuo dated May 8, 1991; (previously considered in US 08/103,961, reference I.A.110).
	973.	Excerpts of the deposition testimony of Drs. Houghton, Choo and Kuo in Civil Action Nos. C-98-02995 CN and C-98-02974 CW.
	974.	Excerpts of the deposition testimony of Drs. Houghton and Choo in Civil Action Nos. C-98-02995 CN and C-98-02974 CW.

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INFORMATION DISCLOSURE CITATION IN A PATENT	Applicant: Michael Houghton et al.		
(several sheets followed)	Filing Date: June 18, 2001	Group Art Unit: 1656 Examiner: William W. Moore Confirmation No.: 1938	
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	Delivery Date: September 4, 20	09	

Examiner Initials	Ref. No.	OTHER DOCUMENTS	(including author, title, date, etc.)		
	1099.	Order Granting Request for Reexamination of the 5,371,017 patent, control no. 90/005,512, issued on December 22, 1999, paper no. 5, 3 pages, and intialled Form 1449 (5 pages), and Notice of Reexamination Request Filing Date, one page (paper no. 3).			
	1100.	Order Granting Request for Reexamination issued on February 22, 2000, paper no., 4	of the 5,371,017 patent, control no. 90/005,582, pages, with U.S. PTO Form 1449.		
	1101.	Office Action in Reexamination of the 5,37 6, 4 pages.	71,017 patent, issued on November 9, 2000, paper no.		
	1102.		otion of the 5,585,258 patent, filed with the United ober 8, 1999, 7 pages, with U.S. PTO Form 1449, 5		
	1103.		of the 5,585,258 patent, control no. 90/005,513, 5 pages, and intialled Form 1449 (5 pages), and ate, one page (paper no. 3).		
	1104.	Office Action in Reexamination of the 5,58	35,258 patent, issued on November 9, 2000, 5 pages.		
	1105.	Patent Owner's Response to Office Action C.F.R. §1.550(b) filed on February 20, 200	in Reexamination of the 5,585,258 patent, under 37 1, 15 pages, with Exhibits A-M.		
	1106.	•	ation of the 5,397,691 patent, filed with the United ober 8, 1999, 7 pages, with U.S. PTO Form 1449, 5		
	1107.		of the 5,397,691 patent, control no. 90/005,514, 4 pages, and intialled Form 1449 (5 pages).		
	1108.	Office Action in Reexamination of the 5,39	97,691 patent, issued on November 9, 2000, 4 pages.		
	1109.	Patent Owner's Response to Office Action C.F.R. §1.550(b) filed on February 20, 200	in Reexamination of the 5,397,691 patent, under 37 1, 15 pages, with Exhibits A-M.		
	967.	Memorandum by Dr. Michael Houghton (ureference I.A.116).	indated); (previously considered in US 08/103,961,		

EXAMINER:	DATE CONSIDERED: